

REMARKS

The Office Action rejects claims 1, 10, 15, 17, 19-21, 24, 25, 30, 33, and 37-41 under the judicially created doctrine of obviousness-type double patenting. In response, Applicant points out that a terminal disclaimer was filed on October 8, 2003, a copy of which is enclosed herein for reference.

The Office Action rejects claims 1, 10, 15, 17, 20, 21, 24, 25, 30, 33, 37-39, 41 and 42 under 35 U.S.C. 103(a) as being unpatentable over Edwards et al in U. S. Patent No. 5,472,411. In response, Applicant has amended the claims to further clarify them from Edwards, and presents the following explanation of the differences between the claims as now recited and Edwards.

Regarding claim 1, Applicant has removed reference to microspheres, and has used the term “gel” in its dictionary defined sense, meaning “a colloid in a more solid form than a sol”, where the definition is from Webster’s Ninth New Collegiate Dictionary. Applicant believes this definition is sufficient for those skilled in the art to know the difference between the “gel” as claimed and a “sol” which is defined from the same dictionary reference as “a fluid colloidal system; esp; one in which the continuous phase is a liquid.”

Claim 1 requires guiding using “a non-invasive imaging technique for viewing inside an area of tissue.” Edwards does not describe use of a non-invasive imaging technique. The Office Action points out that non-invasive imaging techniques are well known in the art. Applicant in response points out that although non-invasive imaging is well known, it is not known to be used for the purpose defined by claim 1 for guiding a needle apparatus, and not known in the specific art of claim 1. Applicant therefore believes claim 1 is now allowable.

Claim 10 is dependent on claim 1, and is believed to be allowable in adding further limitation to an allowable claim.

Regarding claim 15, the Office Action equates the “image contrasting agent” of claim 1 with the “contrast agent” of Edwards col. 17, line 2. Applicant points out that since Edwards does not address non-invasive imaging, the “contrast agent” of Edwards would be for direct visual identification, since Edwards guides the needle through use of direct visual methods using scopes (col. 6, lines 58-59). Applicant therefore believes that claim 15 adds further novelty to novel claim 1. Furthermore, the injecting of an imaging contrasting agent of claim 15 in combination with the non-invasive imaging of claim 1 provides a more complicated and un-

obvious method, providing additional accuracy in treating body tissues. Applicant points out that current methods being used do not provide the accuracy achievable by the method of claim 1 plus claim 15, and this accuracy is much needed in the treatment of certain conditions such as tumors, which need to be precisely destroyed so as not to leave tumor residue on the one hand, and not destroy unnecessary tissue on the other hand. Applicant has more clearly described claim 1 and claim 15, and believes they are a novel and much needed method in treatment of disease..

Regarding claim 17, Applicant believes claim 17 is allowable in adding further limitation to an allowable claim. Edward's reference to the use of "saline" to "reduce desiccation" is for the purpose of assuring electrical contact to the tissue to be destroyed by applied RF energy. The term "desiccation" means "drying", and if the tissue dries, it will not readily conduct the RF energy. Therefore, Edward's use of saline is not a tissue necrosis agent as specified in claim 17, but only is used to assure electrical connectivity to the tissue.

Regarding claim 20, Applicant has amended claim 20 to depend on a new claim 43 to clarify what is described, and to distinguish it from Edwards. New claim 43 is similar to claim 1, except that it specifies "microspheres" and clarifies what is meant by a "microsphere" by describing the microsphere as being a container in which the substance is contained. Claim 20 is dependent on claim 43, and includes elements not described or obvious from Edwards. As mentioned above, Edwards does not describe non-invasive imaging. In addition, Edwards does not describe a non-metallic, bio-absorbable microsphere container in which the substance is contained as described in claim 43. Edward's microsphere uses a metallic container (col. 16, lines 35-36) that is not bio-absorbable. Edward's container has holes in it to allow liquid contents to escape. Edwards has a coating over the metal sphere, and even this coating is not designed to be bio-degradable/absorbable as in claim 43. The coating of Edwards is applied to be burned off when Edwards applies RF energy which heats Edwards metal container. The metal microsphere container of Edwards therefore functions in a much different way from the non-metal container of new claim 43.

Claim 20 therefore now depends on novel claim 43 which is distinguishable over Edwards. Additionally, claim 20 describes the microsphere contents as providing image enhancement when the imaging is an ultrasound technique. In specifying ultrasound, claim 20 in combination with claim 43 upon which it depends, provides detail regarding a system that is

effective and particularly economical to implement, and such a system needs to be promoted, because it is a practical and much improved method in treatment procedures.

Claims 21, 24, 25, 30, 33 and 37 are now believed to be allowable in adding further limitations to an allowable claim.

Claim 38 has been amended to depend on claim 43 and is now believed to be allowable in adding further limitations to an allowable claim.

Claims 39, 40 and 41 are believed to be allowable in adding further limitations to an allowable claim.

Regarding claim 42, this claim has been amended to depend on new claim 43, and is believed to be allowable in adding further limitations to an allowable claim.

CONCLUSION

Applicant has amended the claims in order to distinguish the present invention from the cited prior art, and believes the claims are now in condition for allowance. If any further questions should arise prior to a Notice of Allowance, the Examiner is invited to contact the attorney at the number set forth below.

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Respectfully submitted,

Mark J. Danielson 40.580

for David H. Jaffer
Reg. No. 32,243
Customer No.: 27498

PILLSBURY WINTHROP LLP
2475 Hanover Street
Palo Alto, CA 94304-1114
Tel: (650) 233-4510
Fax: (650) 233-4545

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Diana Dearing